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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: : RONALD A. SCHACHAR
Serial No. : 09/589,626
Filed : June 7, 2000
For : SCLERAL PROSTHESIS FOR TREATMENT OF
PRESBYOPIA AND OTHER EYE DISORDERS
Group No. : 3738
Examiner : David H. Willse

MAIL STOP RCE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRELIMINARY AMENDMENT FOR RCE

Prior to further examination, please amend the above-identified application as follows:

FILING OF RCE:

The Request for Continued Examination pursuant to 37 C.F.R. § 114(a) being filed herewith is proper:

If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:

....

(3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, *unless the appeal or civil action is terminated.*

37 C.F.R. § 1.114(a) (emphasis added). Applicant's appeal to the Court of Appeals for the Federal Circuit terminated on September 28, 2006. However, the application remains pending because on the date of termination the application contained allowed and allowable claims. Claims 22–24 were allowed in the final Office Action dated August 14, 2003. In addition, the decision of the Board of Patent Appeals and Interferences dated November 23, 2004 did not sustain the rejections in the final Office Action of claims 8–11 and 18–21 under either 35 U.S.C. § 101 or 35 U.S.C. § 103(a). The decision of the Board in that regard was not appealed by the Director. Accordingly, pending claims 8–11 and 18–24 in the present application are either allowed or would be allowable if rewritten in independent form including all limitations of the base claim and any intervening claims.

Pursuant to MPEP §§ 1214.06 and 1216.01, the application remains pending and should, at minimum, be passed to issue with (1) the allowed claims and (2) the allowable claims rewritten in independent form:

1214 Procedure Following Decision by Board

1214.06 Examiner Sustained in Whole or in Part

II. CLAIMS STAND ALLOWED

The appellant is not required to file a reply. The examiner issues the application or ex parte reexamination certificate on the claims which stand allowed. For paper files, a red-ink line should be drawn through the refused claims and the notion "Board Decision" written in the margin in red ink.

If the Board affirms a rejection of claim 1, claim 2 was objected to prior to appeal as being allowable except for its dependency from claim 1 and independent claim 3 is allowed, the examiner should cancel claims 1 and 2 and issue the application or ex parte reexamination certificate with claim 3 only.

If the Board affirms a rejection against independent claim 1, reverses all rejections against dependent claim 2 and claim 3 is allowed, after expiration of the period for further appeal, the examiner should either:

(A) Convert dependent claim 2 into independent form by examiner's amendment, cancel claim 1 in which the rejection was affirmed, and issue the application with claims 2 and 3; or

(B) Set a 1-month time limit in which appellant may rewrite dependent claim 2 in independent form.

I. OFFICE PROCEDURE FOLLOWING DECISION BY THE FEDERAL CIRCUIT

B. Some Claims Allowed

Where the case includes one or more allowed claims, including claims allowed by the examiner prior to appeal and claims whose rejections were reversed by either the Board or the court, the proceedings are considered terminated only as to any claims which still stand rejected. It is not necessary for the applicant or patent owner to cancel the rejected claims, since they may be canceled by the examiner in an examiner's amendment. Thus, if no formal matters remain to be attended to, the examiner will pass the application to issue forthwith on the allowed claims or, in the case of a reexamination, will issue a "Notice of Intent to Issue a Reexamination Certificate and/or Examiner's Amendment." See MPEP § 2287. The examiner should

set forth the reasons for allowance, referring to and incorporating a copy of the appellate brief and the court decision. See MPEP § 1302.14.

If formal matters remain to be attended to, the examiner promptly should take appropriate action on such matters, such as by an examiner's amendment or by an Office action setting a 1-month (but not less than 30-day) shortened statutory period for reply. However, the application or reexamination proceeding is considered closed to further prosecution except as to such matters.

MPEP § 1214.06(II), page 1200-59 and § 1216.01(I)(B), page 1200-70 (8th ed. rev. 5 August 2006).

Because the appeal is terminated but the application remains pending, a Request for Continued Examination is proper.